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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,592	04/09/2004	Mark D. Levitt	117-P-1345USD3	1562

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IPLM GROUP, P.A.  
POST OFFICE BOX 18455  
MINNEAPOLIS, MN 55418

EXAMINER

AHMED, SHEEBA

ART UNIT PAPER NUMBER

1773

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/821,592	LEVITT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sheeba Ahmed	1773	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-19 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-19, and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 22, 2006 has been entered.

### ***Response to Amendments***

2. Claims 1, 3-5, 12, and 19 have been amended in the above-identified application. Claims 20-27 and 37 have been canceled. **Claims 1, 3-19, and 36 are now pending.**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-19, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 20 have been further amended to recite that the "topcoat is "sufficiently strip agent permeable" when "subjected to the action of the strip agent". There is no antecedent basis for "the strip agent". How would one skilled in the art

Art Unit: 1773

determine from the written disclosure, including the examples, which strip agent to use in this instance? Such a recitation in the claims gives rise to uncertainty about the scope of the claims.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

4. Claims 1, 3-19, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168).

The above rejection is maintained for the reasons of record as stated in the Office Action mailed on October 5, 2004.

5. Claims 1, 3-19, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lauer et al. (US 5,932,350).

Lauer et al. (US 5,932,350) disclose a method for tandem coating substrate, such as cellulosic substrates, with both highly crosslinked thermoset coatings and aqueous based coatings (Column 1, lines 1-9). The substrate may be coated first with the cured coating (ii) and then the highly crosslinked coating (i) which is preferably formed from a thermoset material that is UV curable and which before cure may be a high solids composition or a waterborne composition (Column 2, lines 31-51). The UV

Art Unit: 1773

curable coatings, after exposure to UV radiation, produce highly crosslinked coatings. It has proved difficult to adhere water-based topcoats without the use of an intermediate coating (Column 3, lines 1-6). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Lauer et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Lauer et al. and as claimed in the instant application is identical. Furthermore, Lauer's coatings must inherently be strippable "without damaging the floors" given that Lauer teaches the same coatings as claimed by the instant Applicants. All limitations of the claimed invention are either disclosed or inherent in the above reference.

6. Claims 1, 3-19, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US 5,494,707).

Wang et al. disclose a resilient floor covering comprising of a resilient support surface and a resilient wear surface adhered to said support surface and comprising an underlying wear layer based coat and an overlying wear layer top coat adhered to said wear layer base coat (Column 3, lines 61-68). The wear layer top coat is a hard thermoset UV curable blend of acrylates (Column 4, lines 7-10). The wear layer base coat has a thickness of 0.7 to 3.0 mils and the wear layer top coat has a thickness of 0.1 to 0.5 mils (Column 8, lines 35-45). Conventional substrate layer comprises materials typical of substrate layers found in the flooring art and include vinyl compositions (Column 9, lines 59-66). With regards to the stripability rating limitations recited in

Art Unit: 1773

claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Wang et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Wang et al. and as claimed in the instant application is identical. Furthermore, Wang's coatings must inherently be strippable "without damaging the floors" given that Wang teaches the same coatings as claimed by the instant Applicants. All limitations of the claimed invention are either disclosed or inherent in the above reference.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1, 3-19, and 36 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 11-16, 18, and 19 of copending Application No. 10/821,560. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The claims are identical.

***Response to Arguments***

8. Applicant's arguments filed on February 22, 2006 with respect to the rejection of claims 1, 3-19, and 36 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168) have been fully considered but they are not persuasive.

Applicants traverse the rejection of the rejection of claims 1, 3-19, and 36 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168) and state that claim 1 addresses the coated floor after the topcoat has been applied and before it cures and hardens. However, the Examiner would like to point out that the language recited in independent claim 1 does not preclude the topcoat from being cured and hardened and hence claim 1 recites a coated floor wherein the topcoat is already cured/hardened. Furthermore, in response to the Examiner's position that the use of a two-part composition does not impart distinctive structural characteristics to the final product, Applicants direct the Examiner's attention to the Declaration filed by Robert D. P. Hei under 37 CFR 1.132 and state that the Declaration shows that the vinyl composition flooring tiles coated with a single layer of PADLOCK acrylic polymer floor finish and over coated with a two-component aqueous polyurethane composition exhibited better leveling and hardened finish appearance than the other comparative samples. However, the Examiner would like to point out that even if she agreed that the Hei Declaration shows that with a single layer of PADLOCK acrylic polymer floor finish and over coated with a two-component aqueous polyurethane composition exhibited better leveling and hardened finish appearance ***that is not the invention being claimed in the instant application. None of the claims are directed to an invention***

Art Unit: 1773

***commensurate in scope with the showing in the Hei Declaration or the***

***Specification.*** The Examiner invites the Applicants to amend the claims to recite an invention commensurate in scope with the showing in the Hei Declaration and the Specification. A claim reciting a coated floor with a strippable intermediate coating and a mixed two part curable composition is simply not the same as a ***vinyl*** floor tile coated with a ***single layer of PADLOCK acrylic polymer*** floor finish and over coated with a ***two-component aqueous polyurethane composition***.

Applicants traverse the rejection of Claims 1, 3-19, and 36 under 35 U.S.C. 102(b) as being anticipated by Lauer et al. (US 5,932,350) and state that Lauer's coatings are "highly cross linked" and are "carbonyl functional" and that Lauer does not state that the coatings "can be stripped without damaging the floors". First, the Examiner would again like to point out that the language of the independent claim does not preclude the topcoat from being "highly cross linked" and/or "carbonyl functional". Second, Lauer's coatings must inherently be strippable "without damaging the floors" given that Lauer teaches the same coatings as claimed by the instant Applicants. Applicants further state that none of Lauer's working examples show a coated floor of the claimed invention. However, "the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain". *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary



Art Unit: 1773

skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Applicants traverse the rejection of Claims 1, 3-19, and 36 under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US 5,494,707) and state that Wang does not teach that the floor can be "be stripped without damaging the floors". However, the Examiner takes the position that Wang's coatings must inherently be strippable "without damaging the floors" given that Wang teaches the same coatings as claimed by the instant Applicants.

Lastly, with regards to the double patenting rejection, the Examiner would like to point out that where the claims of an application are **substantively the same** as those of a first patent (or another application), they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the "**same invention**" type finds its support in the language of 35 U.S.C. 101.

In conclusion, all rejections are maintained for the reasons of record and the Examiner again invites the Applicants to amend the claims to recite an invention

Art Unit: 1773

commensurate in scope with the showing in the Hei Declaration and the Specification, i.e., a claim having at least a ***vinyl*** floor tile coated with a ***single layer of PADLOCK acrylic polymer*** floor finish and over coated with a ***two-component aqueous polyurethane composition***.


### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached Mondays through Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

  
Sheeba Ahmed  
Art Unit 1773  
April 13, 2006